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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,875	12/31/1998	RICHARD C. FENWICK JR.	ONCO-003	4405

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EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
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2611

17

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/223,875

Applicant(s)

FENWICK ET AL.

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 1/9/2004 have been fully considered but they are not persuasive. With respect to the 112 1<sup>st</sup> paragraph rejection, applicant points out that page 21, lines 19-21, discloses "...The SMS 10 then selects an available IPS 20 ACD audiovisual serving device and allocates it to the task of presenting menus to the user. This ACD communicates with the user while presenting the menus using the RCS 14." Applicant also points to page 22, line 16 thru page 23, line 10, which reads "...The SMS 10 allocates a programming subsystem 12 audiovisual serving device ACD to present the user with a set of menus 106 and removes that audiovisual serving device from a list of available audiovisual serving devices 120..."

While it is clear that at the cited portions, the specification discloses that a particular audiovisual serving device ACD 120 is assigned or allocated to a particular user. However, the cited portions of the specification do not explicitly state that a particular ACD 120 is assigned to one and only one user at a particular time. Even though the system detects which ACD's are available before assigning one to a user, the specification does not explicitly define the criteria for the ACD being unavailable. In other words, it is possible that the ACD was already assigned to several users, but was still available to serve one more user. After the ACD was assigned to

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the particular user in the examples cited above, then the particular ACD is unavailable to serve any more users.

Amended claim 1 recites, "...by assigning an assignable computing device to the particular user *only*", emphasis added. Again, examiner points out that the specification does not explicitly state that since the ACD is available to be assigned, it is not presently assigned to any other client(s). The specification does not explicitly disclose that an ACD is only assigned to one particular user at a particular time.

For the reasons set forth above, examiner maintains the 112 1<sup>st</sup> paragraph rejection, it is made final.

***Claim Rejections - 35 USC § 112***

2. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph. Considering amended claim 1, the specification, while being enabling for "allocating a particular ACD to present a menu to a user", as disclosed in the specification page 21, lines 19-21, the disclosure does not reasonably provide enablement for "assigning an assignable ACD to the particular user only". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with this claim.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hwang, (U.S. Pat # 6,049,823).

Considering claim 1, the claimed method of presenting an audiovisual signal to a user's audiovisual display monitor comprising receiving a command from the user and responding to the command by assigning an assignable computing device to the particular user only is met by the disclosure of Hwang that when a viewer requests a private session, the system allocates a particular Channel-processor to that user, col. 13, lines 40-61 & col. 17, lines 15-40. Hwang teaches that each private viewing session requires a dedicated Channel-processor for each customer.

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As for the additionally claimed feature of establishing a communications link between the user's audiovisual device and the ACD, the above disclosure of Hwang reads on the subject matter; also see col. 16, lines 5-8.

The Channel-processor in Hwang reads on an ACD, since it is disclosed that it is a PC, see col. 4, lines 52-60 & col. 13, lines 1-5.

Regarding the feature of presenting a menu containing a selection of video programs to the user's audiovisual display monitor with the ACD, selecting one of the video programs and routing the instant selected video program to the user's audiovisual display monitor, Hwang teaches that once a private viewing session is activated, that the viewer is enabled to select and receive movies on demand from a menu, see col. 16, lines 61-67 & col. 17, lines 50-67 thru col. 18, lines 1-25. Hwang furthermore discloses that on a private viewing channel, the user can order any on-demand services for movies, games and shopping; see col. 1, lines 55-60.

Considering claims 2-3 & 17-18, Hwang teaches an MCI interface to play and control MPEG movies, such that the control panel may be overlaid on top of the movie; see col. 18, lines 5-24.

Considering claims 4-5, 10 & 19-20, Hwang teaches that video programming may be transmitted to viewers using well known RF modulation technology; see col. 6, lines 40-43; col. 9, lines 34-52 & col. 13, lines 64-67 thru col. 17, line 1.

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Considering claims 6-8 & 21-23, Hwang teaches that the user may order currently available movies using a series of catalog pages; col. 1, lines 55-60; col. 17, lines 55-67 thru col. 18, lines 1-25.

Considering claims 9 & 24, the claimed feature of the menus reflecting a set of user preferences reads on the viewer's selection of catalog pages, for instance of categories when selecting movies; see col. 17, lines 55-60.

Considering claim 11, the recited subject matter is inherent in Hwang.

Considering claim 12, 15 & 25, the claimed host-computing device reads on the operation of the iTV server, col. 17, lines 15-61.

Considering claims 13 & 26, the claimed step reads on the viewer selecting a different viewing mode and being assigned a different Channel-processor in Hwang, see col. 17, lines 1-25.

Considering claims 14 & 27, the claimed feature is broad enough to read on the customer tuning to a regular channel, before requesting a private viewing session.

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Considering claim 16, the claimed apparatus for presenting an audiovisual signal to a user's audiovisual monitor, comprising a programming subsystem reads on the iTV stations in Hwang, col. 11, lines 4-24. The claimed Room Communication Subsystem, RCS reads on the operation of the iTV stations, (Fig. 3a; Fig. 5; Fig. 6a&b; col. 7, lines 22-45).

The claimed Site Management Subsystem, SMS also reads on the iTV station & iTV server; see Fig. 2.

As for the recitation of the programming subsystem including a plurality of serving devices communicating with the user's display monitor over the RCS; and the SMS assigning an ACD audiovisual serving device to a particular user to present a menu containing a selection of video programs to the particular user's display monitor over the RCS, the disclosure of Hwang teaches that a viewer may select a private viewing session to retrieve movies, such that the iTV server/stations assign particular Channel-processor to individual users during the private viewing sessions, (Abstract; col. 13, lines 18-54; col. 16, lines 1-10; col. 17).



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**Any response to this action should be mailed to:**

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**Or:**

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*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington,  
VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.  
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9306 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
**VIVEK SRIVASTAVA  
PRIMARY EXAMINER**